

USPTO Serial No. 10/712,157 (Docket No. TIOG-004)

C. APPLICANT'S COMMENTS

Claims 1-20 are pending in this Application, with Claim 1 being amended. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-20 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 2 of the Official Action

The Applicant has amended the Specification in accordance with the Examiner's helpful suggestion.

Paragraphs 3-7 of the Official Action

Paragraph 4 of the Official Action rejected as-filed Claims 1-7, 9-14, 18-20 under 35 U.S.C. §103(a) as being unpatentable over Rointru and Klaassen.

First, Rointru is non-analogous to the present invention and should not be considered in evaluating the patentability of the present invention.¹ Rointru is in the field of the **"motor vehicle industry."** (Column 6, Lines 64-67.) while the present invention is for the **oil industry.** (Page 3, Lines 5-6; Figure 8.) More particularly, Rointru is attachable to a **block of an automobile engine** for tensioning a belt on the automobile engine while the present invention is independently attached to a ground structure for supporting the lower return portion of an elongated flat endless belt of an **oil well pumping unit.** (Figure 8.) In addition, Rointru is only for preventing slippage of a relatively short belt on an engine motor and is not reasonably

¹ "The determination that a reference is from a non-analogous art is . . . twofold. First, we decide if the reference is **within the field of the inventor's endeavor.** If it is not, we proceed to determine whether the reference is **reasonably pertinent to the particular problem with which the inventor was involved.**" *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979). "A reference is **reasonably pertinent** if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992).

USPTO Serial No. 10/712,157 (Docket No. TIOG-004)

pertinent to the problem with which the present inventor was involved (i.e. prevent “oscillating movements” and “jumping” of a return portion of an elongated flat belt for an oil well pumping unit. (Page 3, Lines 6-14.)

The Applicant also respectfully submits the following case law in support that the prior art stated in the Official Action is non-analogous:

- “In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. . . . The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art.” *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).
- “In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. . . . Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.” *Ex parte Clapp*, 227 USPQ 972, 973 (B.P.A.I. 1985).
- “We have reminded ourselves and the PTO that it is necessary to consider “the reality of the circumstances” . . . — in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).
- “The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories. . . . Wang’s SIMMs were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. . . . In contrast, the Allen-Bradley patent relates to a memory circuit for a larger, more costly industrial controller. . . . Thus, there is substantial evidence in the record to support a

USPTO Serial No. 10/712,157 (Docket No. TIOG-004)

finding that the Allen-Bradley prior art is not reasonably pertinent and is not analogous.” *Wang Labs., Inc. v. Toshiba Corp.*, 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993).

Regardless, Rointru in combination with Klaassen do not teach all of the elements as claimed in independent Claim 1. Independent Claim 1 has the following features:

1. (Currently Amended) A drive belt stabilizer system for increasing the tautness of a return portion of a drive belt, comprising:
 - a base;
 - a lower member attached substantially transversely to an upper surface of said base;**
 - an upper member slidably positioned upon said lower member;
 - a support stand attached to said upper member;
 - a roller rotatably positioned within said support stand, wherein said roller is formed for engaging said return portion of said drive belt;
 - a spring positioned within said lower member and said upper member for applying a separating force between thereof;
 - a securing shaft attached to said base and extending through said lower member and said upper member, wherein said securing shaft slidably extends through said support stand; and**
 - a threaded nut threadably attached to a threaded portion of said securing shaft extending through said support stand for limiting an upper position of said upper member.**

First, the references do not teach “a lower member attached substantially transversely to an upper surface of said base.” Second, the references do not teach “a securing shaft attached to said base and extending through said lower member and said upper member, wherein said securing shaft slidably extends through said support stand.” These are important features of the present invention and need to be considered when evaluating the patentability of the claims.

The Office Action states that “Rointru et al. also discloses that it would be possible to include a threaded shaft with nut to prestress the tensioner.” The Applicant respectfully disagrees and requests identification of this subject matter in Rointru.

With respect to dependent Claims 8, 16, paragraph 5 of the Office Action Combines Rointru, Klaassen and Nealy arguing that Nealy teaches the features of these dependent claims


USPTO Serial No. 10/712,157 (Docket No. TIOG-004)

(i.e. "wherein said roller has a length at least two times greater than a diameter of said roller). However, there is no motivation or suggestion in the references themselves or the art to combine Rointru with Klaasen, much less combining all three references together. Rointru is for automobile engine belts, Klaassen is for tensioning chains and cables, and Nealy is for "conveyor belts". Not only are all three of these references in completely separate arts, but there is no motivation for combining the same. In fact, the structures simply are not feasible to combine as any resulting product would not operate as the present invention or would it be capable of operating.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



Michael S. Neustel (Reg. No. 41,221)
NEUSTEL LAW OFFICES, LTD
2534 South University Drive, Suite No. 4
Fargo, North Dakota 58103

12-6-05

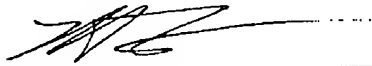
Date

Telephone: (701) 281-8822
Facsimile: (701) 237-0544
e-mail: michael@neustel.com

Attorney's Docket No. TIOG-004

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being faxed to Examiner Marcus Charles at
~~703-872-9306~~ on December 6, 2005.
571-273-8300 *MM 12-6-05*



Michael S. Neustel

NEUSTEL LAW OFFICES, LTD
2534 South University Drive, Suite No. 4
Fargo, North Dakota 58103

Telephone: (701) 281-8822
Facsimile: (701) 237-0544
e-mail: michael@neustel.com